

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. January 19, 2005, Telephone Conference With The Examiner

Applicants thank Examiner Cook for the telephone conference held January 19, 2005, with the Applicants' attorney, Robert Norway. In the conference, the outstanding claim rejections were discussed. In addition, the Examiner proposed the language—"first hair revitalizing"—as in the proposed amendment of claim 25.

II. Disposition of the Claims

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claims 25-42 are pending. Claims 25-27 stand rejected. Claims 28-42 were withdrawn but should be rejoined when the base claim is allowable. See MPEP § 821.04. Claim 25 is currently amended in a manner just mentioned. Even if the amendment were not entered, the claims would be in condition for allowance in view of the remarks that follow.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, thereby placing each claim in condition for allowance. Applicants submit that the proposed amendments of claim 25 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, the Amendment should allow for immediate action by the Examiner.

III. Claim Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 25-27 stand rejected under 35 U.S.C. § 112, First Paragraph, as failing to comply with the written description requirement. See Office action, page 2. In support of the rejection, the Examiner maintained that "[t]he word 'about' includes amounts that are more or less the amounts recited, while '0.1 mg to about 10,000 mg' does allow for the presence of any more or less than the amounts recited." See Office action, page 2. Applicants traverse this rejection.

The test for sufficiency of support under the written description requirement is whether the specification conveys with *reasonable clarity* to those skilled in the art that Applicants were in possession of the claimed invention. See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); see also MPEP § 2163.02. To do so, the specification can expressly, implicitly or inherently support a claim element. See MPEP § 2163. Simply, the PTO must take into account ranges those skilled in the art would consider clearly derivable from the specification as-filed. Cf. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 U.S.P.Q. 177, 179 (Fed. Cir. 1985).

Here, for the reasons previously noted, the claimed range is clearly derivable from the specification as filed. See, e.g., page 14, lines 22-25, of the specification ("Dosage levels on the order of about 0.1 mg to about 10,000 mg of the active ingredient compound are useful"). Plainly, 0.1 and 10,000 are reference points from which those skilled in the art can derive a range.

Moreover, even if the claimed range lacked literal support in the specification as filed, the evidence and explanation of record does not support a *prima facie* case. When testing the sufficiency of recited ranges, the Examiner's analysis must take into account which ranges those skilled in the art would consider expressly, implicitly or inherently supported by the specification. See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); see also MPEP § 2163.05.III.

In *Wertheim*, the challenged application recited an invention having a broad range of 25% to 60% along with specific embodiments of 35% and 50%. See 191 USPQ at 98. Subsequently, the claims were amended to recite a range from 35% to 50%. In holding that the written description requirement was met, the court noted that the “lack of literal support alone” is not enough to meet the Examiner’s burden of showing why those skilled in the art would not recognize the claimed range. Indeed, the claimed range in *Wertheim* was clearly derivable from the specification.

Such is the case in the instant application. The Examiner merely points to an alleged lack of literal support in the specification as filed. See, e.g., Office action, page 2. Here, as in *Wertheim*, the lack of literal support alone is not enough to establish a *prima facie* case. See 191 USPQ at 98. Likewise, here, as in *Wertheim*, the claimed range is clearly derivable from the specification.

Accordingly, this rejection is improper and should be withdrawn.

IV. Non-Statutory Double Patenting Rejection

Claims 25-27 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-24 of U.S. Patent No. 6,239,164. See Office action, page 3. In order to advance prosecution, without addressing the merits of the Examiner’s position, a terminal disclaimer to overcome this rejection is being filed in this case. Thus, the rejection should be withdrawn.

V. Conclusion

It is submitted that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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By 

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 CFR § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.